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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,174	07/17/2000	Ruth Sager	00530-079003	8398

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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 07/10/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/617,174

Applicant(s)

SAGER ET AL.

Examiner

Stephen L. Rawlings, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 and 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-10 is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3-16 and 18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 24,25
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

1. The amendment filed March 31, 2003 in Paper No. 23 is acknowledged and has been entered. Claims 2 and 17 have been canceled. Claims 5 and 6 have been amended.
2. Claims 1, 3-16, and 18 are pending in the application. Claims 13-16 and 18 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 18.
3. Claims 1 and 3-12 are currently under prosecution.

#### ***Grounds of Objection and Rejection Withdrawn***

4. Unless specifically reiterated below, the grounds of objection and rejection set forth in the previous Office action mailed December 31, 2002 (Paper No. 22) have been withdrawn.

#### ***Specification***

5. The specification is objected to because the use of numerous improperly demarcated trademarks has been noted in this application. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks. See MPEP § 608.01(v).

Examples of improperly demarcated trademarks include Clontech™ (page 8), Bio-Rad™ (pages 11 and 24), Biofluor™ (page 14), American Type Culture Collection™ (page 23), and Promega™ (page 25).

Appropriate correction is required. Each letter of a trademark should be capitalized or otherwise the trademark should be demarcated with the appropriate

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symbol indicating its proprietary nature (e.g., <sup>TM</sup>, ®), and accompanied by generic terminology. Applicants may identify trademarks using the "Trademark" search engine under "USPTO Search Collections" on the Internet at <http://www.uspto.gov/web/menu/search.html>.

6. The specification is objected to because of the following informalities:
  - (a) "Bio-Rad<sup>TM</sup>" is misspelled at page 11 and 24.
  - (b) "Biofluor<sup>TM</sup>" is misspelled at page 14.
  - (c) The last two digits of the publication year of the citation at page 26, line 11 have been omitted.

#### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 11 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11 and 12 are drawn to a host cell comprising the vector of claims 5 and 6, respectively. The claims are broadly interpreted to encompass host cells, which are not isolated and are comprised within an organism. Thus, the claims encompass host cells that have been transfected with the vector of claims 5 or 6 that are comprised within a transgenic animal, including a human.

MPEP § 2105 [R-1] states:

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.

#### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making and using an isolated mammary or prostate host cell comprising the vector of claims 5 or 6, does not reasonably provide enablement for any host cell comprising the vector of claims 5 or 6. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claims 11 and 12 are drawn to a host cell comprising the vector of claims 5 and 6, respectively. The claims are broadly interpreted to encompass host cells, which are not isolated and are comprised within an organism. Thus, the claims encompass host cells that have been transfected with the vector of claims 5 or 6 that are comprised within a transgenic animal, including nonhuman or human animals and animals treated using gene therapy.

The teachings of the specification cannot be extrapolated to the enablement of the claimed invention because the amount of guidance, direction, and exemplification set forth therein would not be sufficient to enable the skilled artisan to have a reasonable expectation of success in making and using the claimed invention without the need to perform additional, and an undue amount of experimentation. Factors to be considered in determining whether undue experimentation is required are summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986). These factors include the nature of the invention, the state of the prior art, the relative skill of those in the art, the amount of direction or guidance disclosed in the specification, the presence or absence of working examples, the predictability or unpredictability of the art, the breadth of the claims, and the quantity of experimentation which would be required in order to practice the invention as claimed.

The specification discloses the reporter gene constructs disclosed therein can be introduced into normal prostate or mammary cells at page 2. Furthermore, the

specification discloses the claimed vectors can be incorporated into the genomic DNA of eukaryotic organisms at page 4. Then, at page 5, the specification discloses that the invention disclosed therein features host cells that harbor the vectors; and at page 7, the specification discloses the host cells can be tumor cells.

The specification teaches that the claimed nucleic acid molecule regulates the expression of Maspin in prostate and mammary epithelial cells. The specification discloses that the expression of Maspin that is down-regulated, relative to normal cells, in prostate and breast cancer cell lines, providing sufficient guidance, direction, and exemplification to enable the use of isolated prostate and mammary epithelial host cells transfected with the vector of claims 5 or 6. However, as one skilled in the art cannot predict whether the claimed nucleic acid molecule would function similarly in any other type of cell, the claimed invention cannot be used with a reasonable expectation of success without having need to perform undue experimentation to characterize the function of the nucleic acid molecule in cells other than prostate and mammary epithelial cells.

In addition, the specification does not provide a sufficient amount of guidance, direction, or exemplification to enable the skilled artisan to make or use host cells that are comprised within a non-human transgenic animal. In the art of producing transgenic animals, the phenotype of the resultant transgenic animal is not always predictable or viable. Houdebine (*Journal of Biotechnology* 1994, 34: 269-287) teaches the vectors to be used for directing the expression of transgenes in any given tissue, or in all tissues, must contain the appropriate regulatory regions. Houdebine teaches expression is heavily dependent on the site of integration in the host genome and the site of integration is presently unpredictable. Therefore, it is concluded that one of skill in the art would need to perform undue experimentation in order to make and use the claimed host comprised within a transgenic animal.

Finally, the specification does not teach provide a sufficient amount of guidance, direction, and exemplification to enable the skilled artisan to have a reasonable expectation of successfully producing host cells within a living organism, which comprise the vectors of claims 5 or 6, by gene transfer, or *gene therapy*. The art of

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gene therapy, i.e., the *in vivo* delivery genetic information to targeted cells within a body using naked DNA or viral vectors or by reintroducing *ex vivo* modified host cells into the body, is still in its infancy. Moreover, the art is highly unpredictable and its successful application has been hindered by numerous limitations, which the specification does not remedy and would preclude the skilled artisan from having a reasonable expectation of successfully making and using the claimed invention without need of performing an undue amount of experimentation.

For example, the teachings of the specification have not overcome the problems with *in vivo* delivery and expression. Verma et al. (*Nature* 1997, **389**: 239-242) teach that the Achilles heel of gene therapy is gene delivery. Verma et al. state that the ongoing problem is the inability to deliver genes efficiently and to obtain sustained expression. Similarly, Amalfitano et al. (*Current Gene Therapy* 2002, **2**: 111-133) teach that non-viral mediated transfer of DNA generally suffers from low transduction efficiencies. In addition, Amalfitano et al. discuss numerous limitations that have been encountered in using retroviral vectors to deliver DNA into a subject and teach the use of adenoviral vectors can be ineffective because of the induction of strong immune responses in the host to the viral vectors and direct acute and chronic toxicity caused by the vector itself.

It is noted that Amalfitano et al. teach that a despite general lack of success, the first conclusive evidence that gene therapy can show efficacy in humans was achieved in human X-linked SCID subjects *via* retrovirus transduction. However, since the publication, The Department of Health and Human Services has released a memorandum dated January 14, 2003, a copy of which is attached to this Office action, that urges all such investigations to be discontinued until new data are available, the possible etiology and risks of adverse events associated are considered, and recommendations emerge. Despite the initial promise of the trial studying gene transfer as a possible treatment for the disease, investigators have found that retroviral-mediated insertion of the transgene has caused the subjects to develop cancer. The results of the trial underscore the high degree of unpredictability associated with the art

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and the fact that the skilled artisan could not make or use the claimed invention with a reasonable expectation of success without need to perform additional experimentation.

The state of the art, as a whole, is well defined by Pandha et al. (*Current Opinion in Investigational Drugs* 2000; **1** (1): 122-134) in the abstract. Pandha et al. teach:

Despite the rapid technological advances that continue to sustain the field of cancer gene therapy, few individual patients have benefited from the revolution so far. The plethora of clinical trials described confirms that each malignancy will have its own ideal strategy based on the associated molecular defects, and there has been rapid progress from this viewpoint. At the same time, there has been a renewed appreciation for the limitations to gene therapy, which include low efficiency of gene transfer, poor specificity of response and methods to accurately evaluate responses, and lack of truly tumor-specific targets at which to aim. As with all new therapies, we are climbing a steep learning curve in terms of encountering treatment-related toxicities, as well as profound ethical and regulatory issues.

In view of the preponderance of evidence establishing the state of the art, now and at the time the application was filed, and the level of unpredictability associated therewith, in the absence of a disclosure of an amount of guidance, direction, and exemplification that is reasonably commensurate in scope with the claims, it appears that skilled artisan could not make and use the claimed invention with a reasonable expectation of success without having the need to perform an undue amount of experimentation.

Amending claims 11 and 12 to recite "isolated" before "host cell" can obviate these grounds of rejection.

### ***Conclusion***

11. Claims 11 and 12 are rejected. Claims 1 and 3-10 are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax



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phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

slr  
June 30, 2003



ANTHONY C. CAPUTA  
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